REMARKS

This paper is responsive to an Office Action mailed April 17, 2006. Prior to this response, claims 1-13 were pending. Claims 1-13 remain pending.

Section 10 of the Office Action objects to the drawings under 37 CFR 1.84(p)(5). Specifically, the Office Action states that reference character numbers were not mentioned in the description of Fig. 2. In response, the Applicant notes that the numbers (e.g. file #300) were not intended to be reference designators, but merely exemplary file names. Alternately stated, the description was not written in a manner that identifies any particular image file. However, the Applicant has added a description of image file numbers 13, 191, 300, and 6000 to the specification, which matches Fig. 2. No new matter has been entered. For consistency between the numbers, the "#" symbol before "300" and "6000" numbers has been deleted.

With respect to Fig. 3, the Office Action states that "tennis racquets" should have a reference designator. In response, reference designator "350" has been added to the drawing and specification to identify the term. Reference designator "352" has also been added to identify the box around the term.

Section 12 of the Office Action states that claims 1-3 and 5-12 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Kurzweil et al. ("Kurzweil"; US Patent 6,199,042), in view of Snyder et al. ("Snyder"; US Patent 6,643,641). With respect to claim 1, the Office Action states that Snyder discloses submitting a search term, but

acknowledges that Snyder does not perform an OCR operation, locate the search term, or display the image at the located coordinates. The Office Action states that Kurzweil discloses the OCR/location operations, and that it would have been obvious to apply Kurzweil teachings to Snyder. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Generally, Kurzweil describes a system that accepts a document, scans the document to make an image file 31, and performs an OCR operation to create a OCR data structure 35, which is also referred to as a text file (col. 3, ln. 7-15, see Fig. 2). The image file is shown on a display, and an item from the displayed image (e.g., a word of text) can be selected (col. 3, ln. 53-67, see Fig. 3). Then, the corresponding location in the text file is searched, the information (e.g. word) at the location is determined, and the information is used access a recorded speech sample (col. 4, ln. 11-43).

Snyder discloses a search engine that provides addresses and snapshots as a result of user queries (col. 7, ln. 23-30). Downloaded text files are processed using conventional text processing, such as Boolean operators (col. 9, ln. 62, through col. 10, ln. 7, col. 11, ln. 1-6, and col. 12, ln. 54-58). Search results can be processed to provide search reports or stored in a database (col. 11. ln. 1-18, col. 12, ln. 2-24 and 54-58).

With respect to the first *prima facie* requirement, the Office Action states that an expert would find it obvious to merge elements from search engine and reading machine inventions. However, the Office Action gives no reason to support this assertion. The Applicant respectfully submits that the Office Action should put forth some rationale to explain why an expert in the art would be motivated to modify Snyder, in light of Kurzweil, in a manner that makes the claimed invention obvious. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

With respect to the second *prima facie* requirement, no evidence has been provided that an expert, given the Snyder and Kurzweil disclosures as a foundation, would be likely to create a method that solves the problem addressed by the claimed invention, which is the automatic location of text search terms in an image file.

With respect to the third *prima facie* requirement, even if the references are combined, the combination does not disclose all the limitations recited in claim 1. As acknowledged in the Office Action, Snyder does not disclose the use of OCR, or the searching of an OCR'd document for search terms. The Applicant respectfully submits that

Kurzweil does not disclose these limitations either. Kurzweil describes a process where a user manually identifies a position in a displayed image document. Then, his process uses this position information to locate the corresponding position in the text document, and identifies a term located in the position. This is practically opposite to the procedure described in claim 1, which identifies a term in a text (OCR'd) document, locates the position of the term in the text document, and uses the position information to find the same term in the original image document. While Kurzweil works from the image document to a text document, the claimed invention works from the text (OCR'd) document to the image document. While Kurzweil must manually identify a section of the image document to begin the process, the claimed invention automatically identifies a section of an image document. While the Kurzweil process ends by identifying a text word, the claimed invention process begins with a text word (search term). Because of these differences, it could be said that Kurzweil even teaches away from the limitations of claim 1.

Therefore, the combination of Kurzweil and Snyder fails to explicitly disclose every limitation of claim 1. Neither is there any suggestion that the references be modified in such a manner as to make these missing limitations obvious. Claims 2-3 and 5-12, dependent from claim 1, enjoy the same distinctions from the cited prior art, and the Applicant requests that the rejection be removed.

In Section 13 of the Office Action, claim 4 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Kurzweil and Snyder, in view of Wyle et al. ("Wyle"; US 2004/0243626). The Office Action states that Wyle describes formats that are not disclosed in the Snyder and Kurzweil references. This rejection is traversed as follows.

With respect to the first and second *prima facie* requirement, the Office Action merely states that a skilled artisan would have been motivated to combine Wyle with the other references. The Applicant requests that a rationale be provided that explains how and why and expert would have motivated to combine references.

With respect to the third *prima facie* requirement, even if Wyle's formats are combined with Snyder and Kurzweil, the combination does not describe all the limitations of claim 1. That is, the combination still does not explicitly describe or suggest the limitations of identifying a term in a text (OCR'd) document, locating the position of the term in the text document, and using the position information to find the same term in the original image document, as recited in claim 1. Claim 4, dependent from claim 1, enjoys the same distinctions from the cited prior art, and the Applicant requests that the rejection be removed.

In Section 14 of the Office Action, claim 13 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Kurzweil and Snyder, in view of Palevich et al. ("Palevich"; US 6,889,256). The Office Action states that Palevich describes the location of a sequence of bytes in an image file, which is not disclosed in the Snyder and Kurzweil references. This rejection is traversed as follows.
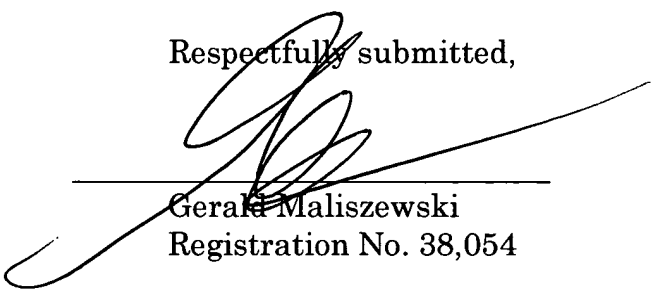
With respect to the first and second *prima facie* requirement, the Office Action merely states that a skilled artisan would have been motivated to combine Palevich with the other references to utilize data stored in compressed image files. The Applicant does not follow how such a rationale suggests modifications in either the Snyder or Kurzweil references.

With respect to the third *prima facie* requirement, even if Palevich is combined with Snyder and Kurzweil, the combination does not describe all the limitations of claim 1. That is, the combinations still does not explicitly describe or suggest the limitations of identifying a term in a text (OCR'd) document, locating the position of the term in the text document, and using the position information to find the same term in the original image document, as recited in claim 1. Claim 13, dependent from claim 1, enjoys the same distinctions from the cited prior art, and the Applicant requests that the rejection be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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